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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,256	08/22/2001	Lutz Biedermann	70301/56223	2209

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EXAMINER

STEWART, ALVIN J

ART UNIT	PAPER NUMBER
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3738

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DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,256

Applicant(s)

BIEDERMANN ET AL.

Examiner

Alvin J Stewart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-12 and 16 is/are allowed.
- 6) ☒ Claim(s) 9, 13-15, 17, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 18, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Drawings

The Examiner withdraws the objection to the drawings filed in the previous Office Action.

Claim Rejection - 35 U.S.C. 112, First Paragraph

The following is a quotation of the first paragraph of **35 U.S.C. 112**:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9, 13-15, and 17-22 are rejected under **35 U.S.C. 112**, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 9, line 9 discloses a tension element capable of transmitting only a tension force between its one end and its other end. The Examiner has not been able to find a paragraph, line or phrase that discloses a tension element capable of transmitting only a tension force. The Applicant is required to show in the specification the limitation claimed in claim 9, line 9. If the Applicant is not able to show in the specification the above limitation, the Applicant has to withdraw the claimed limitations. Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9, 13-15, 17, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Doddroe et al US Patent 6,602,295 B1.

Doddroe et al (see Fig. 2) discloses a prosthetic foot (10A) comprising a first spring element (40) extending from a toe region (see marks by the Examiner) to a lower leg region (130), a second spring element (150) extending from a heel region (see marks by the Examiner) to the lower leg region (130). The springs are connected to each other by an adapter (132) at the upper portion of the prosthetic foot and by a tension element (20). The tension element (20) has two ends, the first end is connected by the heel region and the second end is connected by the toe region (see marks made by the Examiner in Fig. 2). The tension element is a ribbon-like element and is capable of transmitting a tension force between the ends. Finally, the first and the second spring elements are each a leaf spring having a ground-side surface and the elements are arranged and structure to rest and face each other (see Examiner's marks).

Regarding claim 9, the tension element of the Doddroe et al reference is capable to transmit a tension force between its one end and its other end.

Regarding claim 14, the Examiner has interpreted the ribbon-like structure as a strip similar as the strip of fabric. The claims disclosed above are given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

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Allowable Subject Matter

Claims 10-12 and 16 are allowed.

Claims 18, 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments


As discloses in previous rejection, the Examiner has not given patentable weight to the term "only" because of two reasons: 1) the Examiner has not found antecedent basics in the specification; and 2) the term "only" is not a structural limitation, but a capability that the tension element has. The Doddroe reference is capable of transmitting a tension force.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J Stewart whose telephone number is 703-305-0277. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Alvin Stewart
August 15, 2003